

REMARKS

Applicants respectfully acknowledge receipt of the Office Action mailed May 26, 2006.

In the Office Action, the Examiner rejected claims 14-17 and 21-27 under 35 U.S.C. § 102(e) as being unpatentable over *Ueda* (U.S. Patent No. 6,122,009); rejected claims 18-20, 28, and 30-37 under 35 U.S.C. § 103(a) as being unpatentable over *Ueda* in view of *Toyoda et al.* (U.S. Pub. No. 2001/0012073); and rejected claims 29 and 38 under 35 U.S.C. § 103(a) as being unpatentable over *Ueda* in view of *Toyoda*, and further in view of *Basista et al.* (U.S. Patent No. 4,451,124).

By this Amendment, Applicants amend claims 14, 28, and 37. Upon entry of this Amendment, claims 14-38 will remain pending. Of these claims, claims 14, 28, and 37 are independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 14, 28, and 37. No new matter has been introduced.

Applicants traverse the rejections above and respectfully request reconsideration for at least the reasons that follow.

II. 35 U.S.C. § 102(e) REJECTION

Claims 14-17 and 21-27 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over *Ueda*. Applicants respectfully disagree with the Examiner's arguments and conclusions and submit that independent claim 14 is patentably distinguishable over *Ueda* at least for the reasons set forth below.

In order to properly establish that *Ueda* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be

disclosed, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Ueda discloses an image pickup apparatus including a package 2A (which structures the housing of a holder 2) bonded to a substrate 1 with a filler 20, a CCD bare chip 12 disposed on the substrate 1, a lens portion 10 including an image forming lens 4, and four leg portions 11 directly contacting the CCD bare chip 12, with each leg portion 11 contacting a top and side surface of the CCD bare chip 12 and extending beyond the top surface of the CCD bare chip 12 (emphases added). (*Ueda*, Fig. 6, Fig. 10, and col. 8, ll. 4-5 and 36-52). Two of the four side surfaces of each of the four leg portions 11 face the optical axis of the image forming lens 4. (*Id.* at col. 8, ll. 14-19).

Ueda, however, fails to teach or suggest wherein the leg portion 11 does not contact a side surface of an image pickup element and does not extend beyond a top surface the image pickup element (emphases added). In addition, *Ueda* fails to disclose wherein a lens frame is mounted in direct contact with a base board (emphasis added). As illustrated in Fig. 6 of *Ueda*, the package 2A is not mounted in direct contact with the substrate 1, as the filler 20 fills a gap in between the package 2A and the substrate 1 (emphases added). Conversely, Figs. 1 and 2 of the present invention illustrate the lens frame 4 mounted on and in direct contact with the base board PC (emphases added).

Accordingly, with respect to independent claim 14, *Ueda* fails to teach or suggest the claimed combination, including, *inter alia*:

“wherein [a] leg section does not contact [a] side surface of [an] image pickup element and does not extend beyond a top surface the image pickup element, [and] wherein [a] position between [a] lens section and [a] photoelectrically converting section of the image pickup element in a direction perpendicular to [an] optical axis is determined by mounting [a] lens frame in direct contact with [a] base board...”
(emphases added).

The Examiner has therefore not met the essential criteria for showing anticipation, wherein “each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in...a...single reference.” See M.P.E.P. § 2131. Accordingly, independent claim 14 is patentable over *Ueda*. Applicants therefore request that the rejection of claim 14 under 35 U.S.C. § 102(e) be withdrawn and claim 14 be allowed.

Moreover, claims 15-17 and 21-27 are in condition for allowance at least due to their dependence from independent claim 14. In addition, at least some of the dependent claims may recite unique combinations that are neither disclosed nor suggested by the cited art, and therefore some also are separately patentable.

II. 35 U.S.C. § 103(a) REJECTION

Claims 18-20, 28, and 30-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ueda* in view of *Toyoda*. Applicants respectfully disagree with the Examiner’s arguments and conclusions and submit that independent claims 28 and 37 patentably distinguish over *Ueda* and *Toyoda* at least for the reasons described below.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Each of the three requirements, moreover, must "be found in the prior art, and not be based on applicant's disclosure." See M.P.E.P. §2143, 8th ed., February 2003.

As discussed above, *Ueda* discloses an image pickup apparatus including a package 2A (which structures the housing of a holder 2) bonded to a substrate 1 with a filler 20, a CCD bare chip 12 disposed on the substrate 1, a lens portion 10 including an image forming lens 4, and leg portions 11 contacting top and side surfaces of the CCD bare chip 12 and extending beyond the top surface of the CCD bare chip 12 (emphasis added). (*Ueda*, Fig. 6 and col. 8, ll. 4-5, 36-52).

However, as admitted by the Examiner, *Ueda* fails to teach "an elastic member to press the optical member toward the image pickup element with an elastic force in an optical axis direction." (*Office Action*, p. 6, paragraph 8, ll. 4-6). Additionally, *Ueda* fails to disclose wherein the leg portion 11 does not contact a side surface of an image pickup element and does not extend beyond a top surface the image pickup element (emphases added). Moreover, *Ueda* fails to teach or suggest wherein a lens frame is mounted in direct contact with a base board (emphasis added).

Accordingly, in order to cure the deficiencies of *Ueda*, the Examiner relies on *Toyoda* for its alleged disclosure of “an elastic member 110 (figure 8) for absorbing the play of the holder (Paragraph 0003).” (*Id.* at p. 6, paragraph 8, ll. 6-7). Such a teaching, however, still fails to overcome the above noted deficiencies of *Ueda*.

Specifically, with respect to independent claims 28 and 37, *Toyoda* fails to teach or suggest, among other things, the claimed combination including, *inter alia*:

“wherein [a] leg section does not contact [a] side surface of [an] image pickup element and does not extend beyond a top surface the image pickup element, [and] wherein [a] position between [a] lens section and [a] photoelectrically converting section of the image pickup element in a direction perpendicular to [an] optical axis is determined by mounting [a] lens frame in direct contact with [a] base board...”
(emphases added).

The Examiner has therefore not met at least one of the essential criteria for establishing a *prima facie* case of obviousness, wherein “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See M.P.E.P. §§ 2142, 2143, and 2143.03. Accordingly, independent claims 28 and 37, and claims 30-36 that depend from claim 28, are patentable over *Ueda* and *Toyoda*.

Claims 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ueda* in view of *Toyoda*. As explained above, *Ueda* and *Toyoda* fail to teach or suggest, *inter alia*, “wherein [a] leg section does not contact [a] side surface of [an] image pickup element and does not extend beyond a top surface the image pickup element, [and] wherein [a] position between [a] lens section and [a] photoelectrically converting section of the image pickup element in a direction perpendicular to [an] optical axis is determined by mounting [a] lens frame in direct contact with [a] base

board...,” as required by claim 14 (emphases added). Therefore, *Ueda* and *Toyoda* fail to disclose or suggest all of the limitations of claim 14, and claims 18-20 are therefore patentable over *Ueda* and *Toyoda* at least due to their dependence from claim 14.

Applicants therefore request that the rejection of claims 18-20, 28, and 30-37 under 35 U.S.C. § 103(a) be withdrawn.

Claims 29 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ueda* in view of *Toyoda*, and further in view of *Basista*. As explained above, *Ueda* and *Toyoda* fail to teach or suggest, *inter alia*, “wherein [a] leg section does not contact [a] side surface of [an] image pickup element and does not extend beyond a top surface the image pickup element, [and] wherein [a] position between [a] lens section and [a] photoelectrically converting section of the image pickup element in a direction perpendicular to [an] optical axis is determined by mounting [a] lens frame in direct contact with [a] base board...,” as required by claims 28 and 37 (emphases added). *Basista* fails to overcome this deficiency. *Basista* appears to be directed to a photograph lens system including a lens having a glass weight of 264.8 grams. (*Basista*, Abstract and col. 1, ll. 22-25). Such a teaching, however, still fails to overcome the above noted deficiencies of *Ueda* and *Toyoda*. Accordingly, *Basista* fails to teach or suggest “wherein [a] leg section does not contact [a] side surface of [an] image pickup element and does not extend beyond a top surface the image pickup element, [and] wherein [a] position between [a] lens section and [a] photoelectrically converting section of the image pickup element in a direction perpendicular to [an] optical axis is determined by mounting [a] lens frame in direct contact with [a] base

board..." (emphases added). Therefore, *Ueda*, *Toyoda*, and *Basista* fail to disclose or suggest all of the limitations of claims 28 and 37, and claims 29 and 38 are therefore patentable over *Ueda*, *Toyoda*, and *Basista* at least due to their corresponding dependence from claims 28 and 37. Applicants therefore request that the rejection of claims 29 and 38 under 35 U.S.C. § 103(a) be withdrawn.

III. CONCLUSION

Applicants respectfully submit that independent claims 14, 28, and 37 are in condition for allowance. In addition, claims 15-27, 29-36, and 38 are in condition for allowance at least due to their corresponding dependence from claims 14, 28, and 37.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: October 26, 2006

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